

NOV 23 2005

PAGE 2/7 * RCVD AT 11/23/2005 7:22:34 PM [Eastern Standard Time] * SVR:USPTO-EFAXF-6/24 * DNIS:2738300 * CSID: * DURATION(mm:ss):02-02

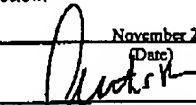
Docket No.: ORAL.001A

CUSTOMER NO. 20995

Applicant : Jerry W. Browning, et al.
App. No. : 10/800,144
Filed : March 12, 2004
For : DISPOSABLE DENTAL
INSTRUMENT
Examiner : Todd E. Manahan
Group Art Unit : 3732

CERTIFICATE OF FAX
TRANSMISSION

I hereby certify that this correspondence
and all marked attachments are being
facsimile transmitted to the Patent and
Trademark Office on the date shown
below:

November 23, 2005
(Date)

Arthur S. Rose, Reg. No. 28,038

**NOTIFICATION OF CORRESPONDING PCT FILING AND REQUEST TO RESCIND
PREVIOUS NONPUBLICATION REQUEST**

35 U.S.C. § 122(b)(2)(B)(ii)

Mail Stop PG Pub
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

A NONPUBLICATION REQUEST WAS FILED ON THE SAME DAY AS A RELATED
FOREIGN APPLICATION WAS FILED

This application was filed with a nonpublication request. On the same day (March 12, 2004) a
corresponding PCT application (Serial Number PCT/US2004/007641) was filed.

RESCISSION OF NONPUBLICATION REQUEST IS PERMITTED AT ANY TIME.

In accordance with 35 U.S.C. § 122(b)(2)(B)(ii) the Applicants hereby rescind the nonpublication
request.

A PETITION TO REVIVE IS NOT APPROPRIATE HERE BECAUSE THIS APPLICATION
IS PENDING UNDER 35 U.S.C. §122(b)(2)(B)(iii).

"An applicant who has made a [nonpublication] request . . . but who
subsequently files [a foreign patent application] . . . shall notify the Director of

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such filing not later than 45 days after the date of filing of [the foreign application] . . . A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it can be shown to the satisfaction of the Director that the delay in submitting the notice was unintentional." 35 U.S.C. §122(b)(2)(B)(iii)

In this case because the PCT application was filed on the same day as the U.S. application, not subsequently, it is respectfully submitted that this application is still pending.

Section 1122 of the MPEP addresses the situation where the foreign application is filed before the U.S. application with a request for nonpublication:

"Where a foreign or PCT application is filed first, and a U.S. application is filed thereafter with an (improper) nonpublication request, the Office will not consider the U.S. application as abandoned for having made the non publication request. This is because the statute only provides for an application to be regarded as abandoned when the applicant fails to notify the Office within 45 days of a subsequently filed [foreign or PCT] application . . . A petition to revive under 37 CFR 1.137(b)(f) is inappropriate and not necessary in the above noted situation because the U.S application is pending . . . " MPEP Section 1122

Although not specifically addressed in MPEP section 1122 it appears that the same logic should apply where as in this case, the PCT application and a corresponding U.S. application, with a nonpublication request, were filed on the same day. This is because the PCT application was not filed subsequently to the U.S. application. The statutory section relating to abandonment for failure to notify the USPTO of a subsequently filed PCT case within 45 days does not apply because the PCT case was filed on the same day and was , not "subsequently filed." Further, in this case the PCT application was published anyway in the normal course on September 30, 2004 (Publication Number WO 2004/082501) which is precisely the same time that the U.S. application would have been published had the nonpublication request not been made. The USPTO confirmed that this is the proper interpretation of the statute in email correspondence held with Mark O. Polutta, Senior Legal Advisor, of the Office of Patent Legal Administration.

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A copy of this email correspondence is attached. Thus, it appears that this case remains pending and that a petition to revive is not appropriate.

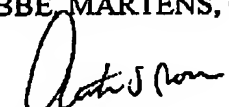
REQUEST THAT THIS PAPER BE TREATED AS A PETITION TO REVIVE IF THE USPTO DETERMINES THAT SUCH A PETITION IS APPROPRIATE

If the USPTO determines that in this case a petition to revive is appropriate then the USPTO is asked to treat this paper as a petition to revive under 37 CFR 1.137(b) and (f) and to charge deposit account number 11-1410 the appropriate fee. The original filing of the nonpublication request was inadvertent and was not discovered until very recently. The entire delay in filing this paper from 45 days after the PCT case was filed until today was unintentional.

Should the Examiner have any questions or comments regarding this paper the Examiner is asked to contact the undersigned at the number indicated below.

Respectfully submitted,
KNOBBE MARTENS, OLSON & BEAR, LLP

Dated: 11/23/05

By: 
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